

Application No.: 09/972,124

Case No.: 56764US002

Remarks

Claims 1-8, 10-21 are pending. Claim 9 has been canceled. Claims 19 and 20 have been withdrawn from consideration.

§ 103 Rejections

Claims 1-8, 10-18, and 21 stand rejected under 35 USC § 103(a) as purportedly being unpatentable over JP Publication 07-098279 (JP '279).

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference must teach or suggest all the claim limitations. (MPEP § 2142)

Claim 1 of the present invention provides an adhesive article comprising a first layer comprising a transparent film, a second layer comprising a fluid transport substrate, a third layer comprising a fluid transportable ink, and an adhesive layer. The first layer (i.e., the transparent-film-comprising layer) has a first major surface and a second major surface opposite the first major surface. A first major surface of the second layer (i.e., the fluid-transport-substrate-comprising layer) is in contact with the second major surface of the first layer. A second major surface of the second layer is in contact with a first major surface of the third layer (i.e., the fluid-transportable-ink-comprising layer). The adhesive layer is in contact with the second major surface of the third layer.

Referring to Fig. 1a and the Brief Description of Drawings, JP '279 describes a base material sheet 1, a first resin layer of lipophilic property 2 including a lipophilic property synthetic resin 2a and basicity or acid powdered material 2b; a second resin layer of hydrophilic property 3, including a hydrophilic synthetic resin 3a, and an acid-base indicator 3b; and transparent surface protection layer 4. (See, page 13.)

According to the Patent Office, transparent surface protection layer 4 corresponds to Applicants' transparent film; first resin layer 3 corresponds to Applicants' fluid transport substrate; and second resin layer, which contains acid-base indicators appears to function as an ink and reads upon Applicants' fluid transportable ink. (See, Paper No. 13, ¶ 2.)

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Assuming *arguendo* that the resin layer 3 containing acid base indicators functions as an ink and reads upon Applicants' fluid transportable ink, as asserted by the Patent Office, this layer is located between the surface protection layer 4 and the purported fluid transport substrate layer 2. That is, both the purported ink layer and the surface protection layer are on the same side of the fluid transport substrate layer. (See, Fig. 1.) In contrast, the present invention requires that the first major surface of the fluid transport substrate be in contact with the transparent layer and the second major surface of fluid transport substrate, opposite the first major surface, be in contact with the fluid transportable ink. (See, e.g., claim 1.) Thus, in the present invention, the fluid transportable ink is on one side of the fluid transport substrate and the transparent layer is on the opposite side. Therefore, JP'279 does not describe, teach or suggest all of the limitations of the claimed invention.

The Patent Office also asserts that an adhesive can be coated on the base material sheet 1 rear face. The Patent Office acknowledges that the Applicants' claims do not read on the presence of an additional layer between the adhesive layer and the ink. Finally, the Patent Office asserts that "such a layer is well within the ordinary skill in the art and might well be desirable. . . ." (See, Paper No. 13, ¶ 2.) Although the addition of such a layer to the Applicants' invention may be desirable, the Patent Office has failed to show how JP'279 provides the suggestion or motivation to remove such a layer to obtain an adhesive layer in contact with the ink layer, as required by the present invention.

Furthermore, even if the base material sheet were removed from JP'279, the resulting construction would have the adhesive layer in contact with resin layer 2, the purported fluid transport layer, not resin layer 3, the purported fluid transportable ink layer. Thus, even assuming there was proper motivation to remove the base material sheet from JP'279, the resulting article would not possess all of the limitations of the claimed invention.

For at least these reasons, the Patent Office has not met its burden in establishing a *prima facie* case of obviousness, and therefore the rejection of claims 1 and 21 under 35 USC § 103(a) as purportedly being unpatentable over JP Publication 07-098279 is unwarranted and should be withdrawn.

Applicants' respectfully traverse the Patent Office's assertion that "[w]ith respect to the dependent claims, these are believed to be, if not expressly or inherently disclosed, obvious

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parameters to one in the water contact indicator art, such as the presence of holes in claims 7 and 8, in the absence of unexpected results." (See, Paper No. 13, ¶ 2.) Applicants respectfully submit that the Patent Office bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the Patent Office does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness. (MPEP § 2142.)

In addition, claims 2-8, and 10-18, each add additional features to claim 1. Claim 1 is patentable for the reasons given above. Thus, claims 2-8, and 10-18 are likewise patentable.

In summary, the rejection of claims 1-8, 10-18, and 21 under 35 USC § 103(a) as purportedly being unpatentable over JP Publication 07-098279 is unwarranted and should be withdrawn.

In view of the above, it is submitted that the application is in condition for allowance. Reconsideration of the application is requested.

Allowance of all pending claims at an early date is solicited.

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Date

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